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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,317	06/08/2001	John J. Sic	19281-001610	9420
20350	7590	12/06/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BOUTAH, ALINA A	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/877,317

Applicant(s)

SIE ET AL.

Examiner

Alina N Boutah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date. 10/15, 03/04, 07/22, 10/17, 11/17,
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Content of Specification***

The disclosure is objected to because of the following informalities: The brief summary of the invention is missing. Appropriate correction is required.

Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose “discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program” as specified in the claimed invention.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the period." There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,701,528 issued to Arsenault et al. (hereinafter Arsenault).

Regarding claim 1, Arsenault teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording at least a first segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs (abstract; figure 8A: 804);

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detecting the user request for one of the first plurality of programs (col. 2, lines 22-25);

recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires (abstract; figures 8A-C; col. 2, lines 22-41; col. 3, lines 24-37; col. 12, line 55 to col. 13, line 65); and

recording the one of the first plurality of programs if the user request is detected before the stagger period expires (abstract; figure 8; col. 2, lines 22-41; col. 3, lines 24-37; col. 12, line 55 to col. 13, line 65).

Regarding claim 2, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the stagger period is a time duration between beginning the first plurality of programs and the second plurality of programs (col. 2, lines 8-21).

Regarding claim 3, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the content provider is a cable television provider (col. 1, line 14).

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Regarding claim 4, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first plurality of programs are multiplexed together in a single datastream (col. 2, lines 32-33).

Regarding claim 5, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein: the first plurality of programs is transported with a first transponder, and the second plurality of programs is transported with a second transponder (col. 18, lines 25-30).

Regarding claim 6, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, further comprising a step of playing the one of the first plurality of programs (col. 2, lines 22-25).

Regarding claim 7, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the detecting step comprises steps of: receiving a wireless request from a remote control (col. 16, lines 26); and processing the wireless request to determine a desired program (col. 16, lines 25-49).

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Regarding claim 8, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (col. 2, lines 22-41).

Regarding claim 9, Arsenault teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored (col. 11, line 60 to col. 12, line 5);

recording any first segment of each of the plurality of programs that are not already stored (col. 12, line 55 to col. 13, line 65);

detecting the user request for one of the plurality of programs (col. 2, lines 22-25); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 2, lines 22-42; col. 12, line 55 to col. 13, line 65).

Regarding claim 10, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of

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recording any remaining segments of the one of the plurality of programs (figure 8; col. 2, lines 22-25).

Regarding claim 11, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different digital channels (figure 8).

Regarding claim 12, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (col. 18, lines 25-30).

Regarding claim 13, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (col. 2, lines 22-25).

Regarding claim 14, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control (col. 16, line 26); and processing the wireless request to determine a desired program (col. 16, lines 25-49).



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Regarding claim 15, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (col. 2, lines 22-41).

Regarding claim 16, Arsenault teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

recording at least a segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs (figure 8A);

detecting the user request for one of the first plurality of programs (col. 2, lines 22-42);  
and

continuing to record the one of the first plurality of programs beyond a stagger period based upon the detecting step (col. 12, line 55 to col. 13, line 65).

Regarding claim 17, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the stagger period is the time between beginning the first plurality of programs and a second plurality of programs (figure 8B).

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Regarding claim 18, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the recording step comprises a step of recording the segment on a mass storage device associated with a set top box that is proximate to the user location (col. 2, lines 22-41).

Regarding claim 19, Arsenault teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of the program sent from the content provider before any user request for the program (figure 8A);

detecting the user request for the program (col. 2, lines 22-25);

recording a second segment of the program if the user request is detected before the period expires (col. 2, lines 22-42; col. 12, line 55 to col. 13, line 65); and

discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program (col. 12, line 55 to col. 13, line 65).

Regarding claim 20, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step

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comprises a step of detecting the user request for the program during the step of recording the first segment (col. 2, lines 22-42).

Regarding claim 21, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 6, lines 56-59).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US 5771009 issued to Nakay.
2. US 6418557 issued to Otani.
3. US 5532735 issued to Blahut et al.
4. US 5850218 issued to LaJoie et al.
5. US 5940738 issued to Rao.
6. US 6487722 issued to Okura et al.
7. US 6510555 issued to Tsurumoto.
8. US 6594826 issued to Rao.
9. US 20020059618 submitted by Venter.
10. US 5682597 issued to Ganek et al.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Thursday (9:00 am - 7:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*ANB*

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